Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PAUL J. RUDECK, FRANCIS BENISTANT and KELLY HURLEY

Appeal No. 2003-2124
Application No. 09/769,162

ON BRIEF

Before KIMLIN, PAK and WARREN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellants request rehearing of our decision of November 17, 2003, wherein we affirmed the examiner's rejections of the appealed claims under 35 U.S.C. §§ 102(b) and 103.

We have thoroughly reviewed the arguments presented in appellants' request, but we find that our decision is free of error.

It is appellants' principal contention that we, as well as the examiner, relied upon appellants' specification as an evidentiary basis for the conclusion of inherency. According to

appellants, "[i]t's legal error to characterize applicants' teachings and discoveries as either part of the prior art or as an admission of facts" (page 2 of Request, first paragraph).

As stated in our decision, "Nakajima does not expressly teach that the presence of the phosphorous doped oxide modifies the re-oxidation oxide profile such that its thickness is reduced compared to a method wherein a layer of phosphorous doped oxide is not used."[1] However, we remain of the opinion that the examiner properly concluded that the process of Nakajima is sufficiently similar to the claimed method that it is reasonable to conclude that the reference process necessarily, or inherently, achieves the claimed effect of reducing the modified re-oxidation oxide profile compared to such profile produced in the absence of a layer of phosphorous doped oxide. The examiner's rationale, which has not been substantively rebutted by appellants, states that much, not all, of the technical reasoning is provided by appellants' specification. Furthermore, appellants' explanation in the specification is tantamount to an admission that the process of Nakajima necessarily produces the claimed reduction in width of the re-oxidation oxide profile. When, as here, the dispositive issue is whether it is reasonable

[1] Page 4 of decision, second paragraph.

to conclude that a prior art process, which is most similar to a claimed process, achieves substantially the same results, it is not an impermissible reliance on an applicant's disclosure to cite the specification disclosure as evidence of an inherent occurrence. For instance, if a claimed three-step process is disclosed as generating oxygen, and a prior art reference discloses a process comprising substantially the same three steps but is silent with respect to the generation of oxygen, it is appropriate to cite the specification as evidence that, prima facie, the prior art process inherently generates oxygen. To conclude otherwise would effectively vitiate the well-established doctrine of inherency in patent jurisprudence.

Appellants' reliance on In re Wertheim, 541 F.2d 257, 269, 191 USPQ 90, 102 (CCPA 1976) is misplaced. The court held in Wertheim that the claimed density of the final product was produced by regulation or control of the foam density and solids content, and no such control was taught by the prior art. As for appellants' citation of Ex parte Lemoine, 46 USPQ2d 1420, 1430 (BPAI 1994), the doctrine of inherency was not at issue. Moreover, Lemoine was precedential on the sole issue of the construction of 35 U.S.C. § 134, not for the rejection under 35 U.S.C. § 103.

Appellants urge that their specification disclosure that the layer of phosphorous doped oxide acts as a barrier to oxygen is not an admission that this knowledge is prior art. However, appellants have failed to offer any explanation how the phosphorous doped oxide layer of Nakajima does not also, necessarily, act as a barrier to oxygen.

In conclusion, based on the foregoing, appellants' request is granted to the extent that we have reconsidered our decision, but denied with respect to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHUNG K. PAK Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CHARLES F. WARREN Administrative Patent Judge	)	

ECK:clm

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